

REMARKS

Claims 1-6 and 8-18 are pending in this application. Claims 1, 10 and 12 are the independent claims. No claims are amended in response to the outstanding rejections.

Claim Rejections under 35 U.S.C. §103

Claims 1-4, 9, and 12-15 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent Publication 2004/0188920 to Washington et al. ("Washington") in view of U.S. Patent 4,604,706 to Fisher, Jr. et al. ("Fisher"). The rejection is respectfully traversed.

In rejecting the claims, it is alleged that Washington discloses a money-operated machine. However, Washington does not disclose a money operated machine. Rather, Washington discloses a machine that dispenses money (i.e., an ATM). The ATM of Washington is operated by inserting a smart card into the card reader 14 that is connected to a series of controllers 22, 24 and communication devices 26, 28 that verify the smart card access authorizations with a bank. Upon approval of the request associated with the smart card at the ATM, currency is dispensed from the ATM. Thus, the ATM is not a money-operated machine.

Applicants respectfully remind the Examiner that when examining claims, the "claims yet unpatented are to be given their broadest reasonable interpretation consistent with the specification during an examination of a patent application" (*In re Prater*, 415, F. 2d 1493 (1969)). This standard is also provided as the standard for claim interpretation under MPEP §2111 which recites that "during patent examination the pending claims must be given the broadest reasonable interpretation consistent with the specification." Further, according to the U.S. Supreme Court, the

specification is the “primary basis for construing claims” and is the “single best guide to claim meaning” because the specification, as set forth by statute, describes the claimed invention in full, clear, concise and exact terms (*Phillips v. AWH Corp.*, 415 F.3d 1303 (Fed. Cir. 2005)). Therefore, the ATM of Washington cannot be interpreted as a “money-operated machine” as such an interpretation is inconsistent with the meaning of the term as used in the specification.

In addition to the above deficiencies of Washington, it is admitted in the Office Action that Washington fails to disclose or suggest a rechargeable voltage source that supplies power to electrical loads of the machine outside of the cashbox, the voltage source being integrated in the cashbox to form a common replacement unit, the replacement unit including an interface via which the voltage source is connectable to the electrical loads of the machine when the replacement unit is positioned in the machine.

It is alleged in the Office Action that one of skill in the art would have modified the ATM of Washington according to the teachings of Fisher “for the purpose of maintaining operation remotely where there is no direct link to a power grid.” However, as noted above, Washington fails to disclose or suggest an interface via which the voltage source is connectable to the electrical loads of the machine when the replacement unit is positioned in the machine. Thus, it does not appear that the ATM of Washington requires a battery in the cassette to power the device. Rather, the ATM appears to have an outside power source that operates the sheet dispensers 34-40, transports 54, 60, belts 56, 62, rollers 58, 64, controllers 22, 24, communication devices 26, 28, display 18, card reader 14, as well as the several motors that are not shown but must be present to operate the ATM. Accordingly, it is at best unclear why one of skill in the art would seek to modify the ATM to be operable by the battery pack

336 when the ATM is clearly designed to operate without such a power source. In other words, the ATM is designed to operate on a power source other than the battery pack 336. The battery pack is only disclosed as being operatively connected to a processor and the keypad. Thus, there is no motivation or suggestion to modify Washington as proposed in the Office Action.

Moreover, Fisher relates to a device to continuously monitor structural load changes in underground mines and has provided warnings of imminent structural failure with prediction times of five or more minutes. The device of Fisher has been used extensively in underground coal mines where portability, battery operation, and U.S. Mine Safety and Health Administration certification for use in gassy mine environments are required.

It is alleged in the Office Action that one of skill in the art would have modified the ATM of Washington according to the teachings of the apparatus for failure prediction of earth structures (mines) as taught by Fisher for the purpose of maintaining operation of the ATM remotely where there is no link to a power grid.

In making an assessment of the differences between the prior art and the claimed subject matter, 35 USC §103 specifically requires consideration of the claimed invention “as a whole.” The “as a whole” instruction in §103 prevents evaluation of the invention on a part-by-part basis. Without this important requirement, an obviousness assessment might break an invention into its component parts, then find a prior art reference corresponding to each component. This line of reasoning would import hindsight into the obviousness determination by using the invention as a roadmap to find its prior art components (*Ruiz v. A.B. Chance., Co.*, 357 F.3d 1270, 1275, (Fed. Cir. 2004)).

By combining the teachings of Fisher, which do not relate to an ATM or addresses the problems being resolved in Washington, the Office Action fails to consider the Fisher reference as a whole and merely seeks to find a reference that may provide the component that is admitted as being deficient in Washington. "Decomposing an invention into its constituent elements, finding each element in the prior art, and then claiming that it is easy to reassemble these elements into the invention, is a forbidden ex-post analysis." (*In re Mahurker*, 831 Fed. Supp. 1801, 28 USPQ 2d 1801).

Because neither the invention, nor the prior art, is being considered as a whole, but rather is being broken down into its constituent elements in an effort to present all features of the claimed device, the combination of Fisher is improper as it merely puts hindsight in the line of reasoning and fails to provide proper motivation or suggestion to make the combination.

Applicants also respectfully remind the Examiner that "[A] patent composed of several elements is not proved obvious merely by demonstrating that each of its elements was, independently, known in the prior art." *See KSR Int'l Co. v. Teleflex Inc.*, 550 U.S. 398, 418 (2007).

Regarding the rejection of claims 3, 13 and 14, it is alleged that the cassette in Washington "is capable" of being held in a transportation frame arranged in a transformation vehicle. However, no evidence of such a capability is provided in the Office Action. Further, there is no description of such a capability in Washington. As such, *prima facie* obviousness has not been established for claims 3, 13 and 14. Therefore, withdrawal of the rejection is required and the final rejection of the claims should also be withdrawn until such time as proper grounds for rejection are provided.

Regarding the rejection of claims 4, 9 and 15, it is alleged that the cassette in Washington "is capable" of being held in a storage frame having a charging station and located at a cashbox emptying location or at a charging station. However, no evidence of such a capability is provided in the Office Action. Further, there is no description of such a capability in Washington. As such, *prima facie* obviousness has not been established for claims 4, 9, and 15. Therefore, withdrawal of the rejection is required and the final rejection of the claims should also be withdrawn until such time as proper grounds for rejection are provided.

Because the combination of references is improper and because *prima facie* obviousness has not been established for the rejection of all of the claims, withdrawal of the rejection is requested.

Claims 5, 16, and 18 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Washington in view of Fisher and further in view of U.S. Patent Publication 2005/0158616 to Heatly ("Heatly"). The rejection is respectfully traversed.

Claims 5, 16, and 18 are allowable for their dependency on their respective base claims, as well as for the additional features recited therein.

Claims 6 and 10 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Washington in view of Fisher and further in view of U.S. Patent 5,615,625 to Cassidy et al. ("Cassidy"). The rejection is respectfully traversed.

Claim 6 is allowable for its dependency on independent claim 1 for the reasons discussed above, as well as for the additional features recited therein.

Further, independent claim 10 is allowable over the combination of references because Washington fails to disclose or suggest a replacement unit that powers

electrical loads outside of the cashbox or a cashbox arranged in a holding frame, the holding frame being arranged in at least one of a transportation vehicle and at least one of a cashbox-emptying location and a charging location.

In addition to the deficiencies of Washington, it is alleged that Cassidy discloses an intelligent container 20 (presumed to be intended to correspond to the claimed "cashbox") with a rechargeable voltage source. Column 3, lines 34-40 describe a battery charging output in the circuitry of the docking station 18 for an internal battery of the secure container. However, there is no disclosure that the alleged battery in the secure container 20 powers electrical loads outside of the container. Further, Fig. 5 shows the electronic circuitry of the container 20. It is notable that not only is there no battery or other power source shown, there is clearly nothing to indicate that the alleged battery in the secure container 20 powers electrical loads outside of the container. As such, the combination of references fails to render independent claim 10 obvious.

Claims 8, 11, and 17 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Washington in view of Fisher and further in view of U.S. Patent 5,732,812 to Grainger et al. ("Grainger"). The rejection is respectfully traversed.

Claims 8, 11, and 17 are allowable for their dependency on their base claim for the reasons discussed above, as well as for the additional features recited therein. Therefore, withdrawal of the rejection is requested.

CONCLUSION

Accordingly, in view of the above amendments and remarks, reconsideration of the objections and rejections and allowance of each of the pending claims of this application is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact John W. Fitzpatrick at the telephone number of the undersigned below.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 08-0750 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,

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